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Timothy Addington

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ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER

SCHNURR, JOHN R

ART UNIT

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2421

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/712,832	Applicant(s) ADDINGTON ET AL.	
	Examiner JOHN R. SCHNURR	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 and 44-130 is/are pending in the application.
- 4a) Of the above claim(s) 1-39, 54-106, 117-120 and 125-130 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-42, 44-53, 107-116 and 121-124 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/30/2008, 10/17/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Amendment After Non-Final Rejection filed 08/22/2008. Claims 40-42, 44-53, 107-116 and 121-124 are pending and have been examined.
2. The information disclosure statements (IDS) submitted on 07/03/2008 and 10/17/2008 were considered by the examiner.

Response to Arguments

3. Applicant's arguments filed 08/22/2008 have been fully considered but they are not persuasive.

In response to applicant's argument (Remarks pg. 42 para. 1 to pg. 43 para. 2) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the network service provider adapting for a particular set top box) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument (Remarks pg. 44 para. 2) that Borelli does not select a particular service provider using the user's host type as a basis, the examiner respectfully disagrees. Borelli clearly teaches scanning the client device to determine physical attributes of the machine and using these attributes as a basis for service provider selection ([0038] and [0040]). Furthermore, because Borelli discloses a service provider is selected based on the user's host information there must be a database relating the host with services.

In response to applicant's argument (Remarks pg. 44 para. 3) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the network will adapt so as to communicate properly with the set top box) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument (Remarks pg. 44 para. 5 to pg. 45 para. 1) that the combination of Tamura does not disclose receiving the host type information from a computer but rather from a set top box, the examiner respectfully disagrees. Tamura clearly teaches the STB 104 comprises a processor executing program steps stored in a memory ([0022] and [0033]).

In response to applicant's argument (Remarks pg. 45 para. 3 to pg. 46 para. 3) that Borelli does not disclose generating a host-specific configuration message based on a host protocol file associated with a host type, the examiner respectfully disagrees. Borelli clearly teaches selecting services based on host information ([0038]) and instituting provisioning actions at the device level to provision the user ([0070]).

In response to applicant's arguments (Remarks pg. 46 para. 4 to pg. 50 para. 2) please refer to the above comments as well as the detailed rejection below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **40-42, 44-53, 107-116 and 121-124** are rejected under 35 U.S.C.

103(a) as being unpatentable over **Borelli et al. (US Patent Application**

Publication 2006/0020525), herein Borelli, in view of **Tamura (US Patent**

Application Publication 2003/0048380).

Consider **claim 40**, Borelli clearly teaches a system for provisioning a service comprising:

an Internet Service Provisioning Gateway (ISPG) operatively connected to a communications network, **(Fig. 2 ISP website 20)** capable of hosting a web site accessed by a user at a computer connected to the communications network wherein the ISPG is configured to provide cable service options to the computer **(The website displays the available service options, [0048].)** and receiving a first provisioning message comprising service related input data entered by the user comprising a user identifier, the ISPG capable of generating a second provisioning message including the service related input data and the user identifier; an enhanced services system (ESS) operatively connected to the ISPG receiving said second provisioning message. **(The customer selects the desired services and provides contact information, [0052], and client information, [0038], this information is then forwarded to provisioning manager 48, Fig. 11 [0064].)**

However, Borelli does not explicitly teach said ESS using said host identifier to ascertain a host file associated with a host type, said host type determined in part by said host identifier, the host file used to identify a host protocol file used for generating a message for provisioning a host identified by said host identifier.

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In an analogous art, Tamura, which discloses a system for provisioning a set-top box, clearly teaches an ESS using a host identifier to ascertain a host file associated with a host type, said host type determined in part by said host identifier, the host file used to identify a host protocol file used for generating a message for provisioning a host identified by said host identifier. **(Fig. 3 Steps 310 and 314 [0027])**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Borelli by using a host identifier to ascertain a host file associated with a host type, said host type determined in part by said host identifier, the host file used to identify a host protocol file used for generating a message for provisioning a host identified by said host identifier, as taught by Tamura, for the benefit of providing system specific provisioning of the set-top box (see [0004] Tamura).

Consider **claim 41**, Borelli combined with Tamura, as in claim 40, clearly teaches the second provisioning message further includes a host manufacturer identifier and a host model identifier. **(Device type and serial number [0027] Tamura)**

Consider **claim 42**, Borelli combined with Tamura, as in claim 40, clearly teaches the second provisioning message further includes a conditional access module identifier. **(Smart card identifier [0027] Tamura)**

Consider **claim 44**, Borelli combined with Tamura, as in claim 40, clearly teaches the host file contains a configuration message associated with the host type, **([0027] Tamura)** the configuration message further associated with a service identified by the service related input data. **(The provisioning manager 48 sends a provisioning message containing the selected services, [0066]-[0067] Borelli.)**

Consider **claim 45**, Borelli combined with Tamura, as in claim 40, clearly teaches the ESS is capable of generating a legacy based command to a cable headend. **(Fig. 11: The provisioning message is provided to adapters 58 which interface with the designated provider, [0067] Borelli.)**

Consider **claim 46**, Borelli combined with Tamura, as in claim 40, clearly teaches the legacy based command initializes a host. **(The service provider uses the service order to provision the customer, [0067] Borelli.)**

Consider **claim 47**, Borelli combined with Tamura, as in claim 40, clearly teaches the ESS is capable of generating a third provisioning message

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that is received by a host on a cable network. **(The provisioning manager institutes the necessary actions at the device level, for example custom software installation, [0070] Borelli.)**

Consider **claim 48**, Borelli combined with Tamura, as in claim 40, clearly teaches the ISPG is operatively connected to a location serviceability database. **(Fig. 2: Database 28 stores information indicating locations that maybe serviced, [0041] Borelli.)**

Consider **claim 49**, Borelli combined with Tamura, as in claim 40, clearly teaches the location serviceability database receives location data associated with the user and selects at least one cable system provider based on the location data. **(The database receives customer location data and selects services available to the customer, [0041] and [0048] Borelli.)**

Consider **claim 50**, Borelli combined with Tamura, as in claim 40, clearly teaches the ISPG is capable of selecting one of a plurality of ESSs operatively connected to the ISPG, the selection determined in part on data received from the computer. **(Based on the services selected by the customer the provisioning message is transmitted to the selected providers, [0067] Borelli.)**

Consider **claim 51**, Borelli clearly teaches a system for provisioning a service comprising:

an Interact Service Provisioning Gateway (ISPG) operatively connected to the Internet, capable of hosting a web site, **(Fig. 2 ISP website 20)** the web site configured to receive service related input data from a cable subscriber as a computer connected to the Internet and provide cable service options to be displayed on the computer, **(The website displays the available service options, [0048].)** wherein said service related input data comprises an indication of the user's host type **([0038] and [0040])**, the ISPG configured to receive from the computer both said service related input data and cable subscriber location data, the ISPG configured to generate a first provisioning message having a first format including the cable subscriber location data; **(The database 28 receives customer location data and selects services available to the customer, [0041] and [0048].)**

a serviceability database operatively connected to the ISPG to receive the first provisioning message, the serviceability database containing a plurality of cable service provider location data **(Fig. 2: Database 28 stores information indicating locations that**

maybe serviced, [0041].) and a plurality of cable service provider identifiers wherein each cable service provider identifier is further associated with at least one host type **([0038] and [0040])**, the serviceability database capable of receiving the cable subscriber location data and selecting a cable service provider identifier compatible with said subscriber location data and said indication of the user's host type, the serviceability database further capable of generating a second provisioning message including service related input data. **(The database receives customer location data and host type and selects services available to the customer, [0041] and [0048].)**

However, Borelli does not explicitly teach transmitting a host identifier.

In an analogous art, Tamura, which discloses a system for provisioning a set-top box, clearly teaches providing a host identifier including a conditional access module identifier when provisioning a set-top box. **(Fig. 3 Step 310 [0027])**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Borelli by transmitting a host identifier to the enhanced services system, as taught by Tamura, for the benefit of providing system specific provisioning of the set-top box (see [0004] Tamura).

Consider **claim 52**, Borelli combined with Tamura, as in claim 50, clearly teaches an enhanced services system is operatively connected to the ISPG and is capable of receiving a third provisioning message containing the service related input data, **(The desired services are provided to the provisioning manager 48, Fig. 11 [0064] Borelli.)** the ESS further capable of receiving a subscriber identifier **(Workflow manager 50 provisions a service for a specific customer, [0066] Borelli.)** and selecting a host file based in part on the host type identifier and the service related input data, **([0027] Tamura)** the ESS configured to transmit a configuration message to the user's host, wherein the configuration message is derived from the host file. **(The provisioning manager institutes the necessary actions at the device level, for example custom software installation, [0070] Borelli.)**

Consider **claim 53**, Borelli combined with Tamura, as in claim 50, clearly teaches the ESS is further configured to authenticate the third provisioning message received from the ISPG prior to generating the configuration message. **([0061] Borelli)**

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Consider **claim 107**, Borelli clearly teaches a method of provisioning a cable service comprising:

receiving service related data from a cable subscriber using a first computer to access a web site, wherein said service related data comprises a cable subscriber identification data and service related data for services requested by the user; **([0037] and [0048])**

generating a first provisioning message with a first format at a second computer hosting the web site, the first provisioning message containing the cable subscriber identification data and the service related data; **(The desired services are provided to the provisioning manager 48, Fig. 11 [0064].)**

receiving the first provisioning message at an enhanced services system; **(The desired services are provided to the provisioning manager 48, Fig. 11 [0064], including subscriber identifiers and host types, [0037]-[0038].)**

determining in the enhanced services system a host type associated with the cable subscriber identification data; **([0038] and [0040])**

selecting a host file in the enhanced services system based on the service related data;

generating a host-specific configuration message based on a host protocol file; and

sending the host-specific configuration message to a host associated with the cable subscriber. **([0070])**

However, Borelli does not explicitly teach a database storing a file maintaining an association of cable subscribers and their respective host types.

In an analogous art, Tamura, which discloses a system for provisioning a set-top box, clearly teaches a database storing a file maintaining an association of cable subscribers and their respective host types. **([0027])**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Borelli by storing a file maintaining an association of cable subscribers and their respective host types, as taught by Tamura, for the benefit of providing system specific provisioning of the set-top box (see [0004] Tamura).

Consider **claim 108**, see claim 107.

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Consider **claim 109**, see claim 50.

Consider **claim 110**, see claim 42.

Consider **claim 111**, Borelli combined with Tamura, as in claim 107, clearly teaches the cable service data pertains to a digital video program offered on a cable network. **(The services include services provided by broadband content providers and broadband service providers, i.e. cable services, [0030] Borelli.)**

Consider **claim 112**, Borelli combined with Tamura, as in claim 107, clearly teaches the cable service data pertains to high speed Internet access. **([0030] Borelli)**

Consider **claim 113**, see claim 107.

Consider **claim 114**, see claim 107.

Consider **claim 115**, Borelli combined with Tamura, as in claim 114, clearly teaches the one provisioning message is received at an enhanced services system (ESS) associated with the service provider. **([0064] Borelli)**

Consider **claim 116**, Borelli combined with Tamura, as in claim 114, clearly teaches the one provisioning message is received at a billing system associated with the service provider. **([0063] Borelli)**

Consider **claim 121**, see claim 40.

Consider **claim 122**, Borelli combined with Tamura, as in claim 121, clearly teaches the host type is determined in part using the user identifier. **(Identifying information includes device type, [0027] Tamura.)**

Consider **claim 123**, Borelli combined with Tamura, as in claim 121, clearly teaches the host type is determined by a parameter contained in the second message. **(Host type is sent to the provisioning system, [0027] Tamura.)**

Consider **claim 124**, Borelli combined with Tamura, as in claim 121, clearly teaches the ISPG determines the enhanced services system based on the cable network provider. **([0064] Borelli)**

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN R. SCHNURR whose telephone number is (571)270-1458. The examiner can normally be reached on Monday - Friday, 8:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

JRS